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Supreme Court, U.S.
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No. 02–428

IN THE
SUPREME COURT OF THE UNITED STATES

DASTAR CORPORATION,
Petitioner,

v.

TWENTIETH CENTURY FOX FILM CORPORATION, SFM ENTERTAINMENT LLC AND NEW LINE HOME VIDEO, INC.,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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BRIEF *AMICI CURIAE* OF AMERICAN LIBRARY ASSOCIATION, ASSOCIATION OF RESEARCH LIBRARIES, SPECIAL LIBRARIES ASSOCIATION, MEDICAL LIBRARY ASSOCIATION, AMERICAN ASSOCIATION OF LAW LIBRARIES, DIGITAL FUTURE COALITION, U.S. ASSOCIATION FOR COMPUTING MACHINERY, ELECTRONIC FRONTIER FOUNDATION, PUBLIC KNOWLEDGE, NETCOALITION, COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION, AND BLOOMBERG L.P. IN SUPPORT OF PETITIONER

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Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) ..... *passim*

Frontline Test Equipment, Inc. v. Greenleaf Software, Inc., 10 F. Supp. 2d 583 (W.D. Va. 1998) 10

Goldstein v. California, 412 U.S. 546 (1973) 10

Graham v. John Deere Co., 383 U.S. 1 (1966) 17

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Higher Gear Group v. Rockenbach Chevrolet Sales, Inc., 2002 U.S. Dist LEXIS 15474 (N.D. Ill. 2002) 9

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Novell, Inc. v. Network Trade Ctr., Inc., 187 F.R.D. 657 (D. Utah 1997) 9

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Ticketmaster Corp. v. Tickets.com, Case No. CV99-7654, 2000 U.S. Dist. LEXIS 12987 (C.D. Ca. August 10, 2000) 11

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Waldman Publ'g Corp. v. Landoll, Inc., 43 F.3d 775 (2d Cir. 1994) 6

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OTHER AUTHORITIES

Jonathan Band and Makoto Kono, *The Database Protection Debate in the 106th Congress*, 62 Ohio St. L. J. 869, 871 (2001) 14, 15

Jonathan Band and Laura F.H. McDonald, *The Proposed EC Database Directive: The "Reversal" of Feist v. Rural Telephone*, 9 The Computer Lawyer 19 (June 1992) 15

Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 Berkeley Tech. L.J. 535 (2000) 15

Dan L. Burk, *The Trouble with Trespass*, 4 J. Small & Emerging Bus. L. 27 (2000) 12

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Edward W. Chang, *Bidding on Trespass: eBay, Inc. v. Bidder's Edge, Inc. and the Abuse of Trespass Theory in Cyberspace Law*, 29 AIPLA Q. J. 445 (2001) 12

Julie E. Cohen, *Copyright and The Jurisprudence of Self-Help*, 13 Berkeley Tech. L.J. 1089 (1998) 17

H.R. Rep. No. 106-349 (1999) 15

H.R. Rep. No. 105-525 (1998) 16

Dennis S. Karjala, *Federal Preemption of Shrinkwrap and On-Line Licenses*, 22 U. Dayton L. Rev. 511 (1997) 10

Niva Elkin-Koren, *Let the Crawlers Crawl: On Virtual Gatekeepers and the Right to Exclude Indexing*, 26 U. Dayton L. Rev. 179 (2001) 12

Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property*, 87 Calif. L. Rev. 111 (1999) 10

Charles R. McManis, *The Privatization (or "Shrinkwrapping") of American Copyright Law*, 87 Calif. L. Rev. 173 (1999) 10

Melville B. Nimmer and David Nimmer, Nimmer on Copyright (2002) 10

Maureen A. O'Rourke, *Shaping Competition on the Internet: Who Owns Product and Pricing Information?*, 53 Vand. L.Rev. 1965 (2000) 12

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William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 Geo. Wash. L. Rev. 359 (1999) 16, 18

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INTEREST OF *AMICI CURIAE*[1]

The American Library Association (ALA), the oldest and largest library association in the world, is a nonprofit organization of over 64,000 librarians, library trustees, and other friends of libraries dedicated to the development, promotion, and improvement of library and information services to enhance learning and ensure access to information for all.

The Association of Research Libraries (ARL) is a nonprofit organization of 124 research libraries in North America. ARL programs and services promote equitable access to and effective use of recorded knowledge in support of teaching, research, scholarship and community service.

The American Association of Law Libraries (AALL) is a nonprofit educational organization with 5,000 members dedicated to providing leadership and advocacy in the field of legal information and information policy.

The Medical Library Association (MLA) is a nonprofit, educational organization of more than 1,100 institutions and 3,800 individual members in the health science information field.

The Special Libraries Association (SLA) is an international professional association serving more than 14,000 members of the information profession, including special librarians, information managers, brokers, and consultants.

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[1] Letters from all parties consenting to the filing of this brief are being filed with the Clerk of this Court along with this brief. No counsel for a party authored this brief in whole or in part, and no person other than *amici curiae*, or their counsel, made a monetary contribution to the preparation or submission of this brief.

Digital Future Coalition (DFC) is committed to striking an appropriate balance in law and public policy between protecting intellectual property and affording public access to it. The DFC is the result of a unique collaboration of many of the nation's leading non-profit educational, scholarly, library, and consumer groups, together with major commercial trade associations representing leaders in the consumer electronics, telecommunications, computer, and network access industries. Since its inception in 1995, the DFC has played a major role in the ongoing debate regarding the appropriate application of intellectual property law to the emerging digital network environment.

U.S. Association for Computing Machinery (Public Policy Committee) is a leading professional association of computer scientists and other information technology professionals dedicated to advancing the art, science, engineering and application of information technology. The United States Public Policy Committee of the Association for Computing Machinery (USACM) serves as the focal point for ACM's interactions with U.S. government organizations and the science and technology policy community.

Electronic Frontier Foundation (EFF) is a nonprofit public interest organization dedicated to protecting civil liberties and free expression in the digital world. EFF actively encourages and challenges industry and government to support free expression, privacy, and openness in the information society. Founded in 1990, EFF is based in San Francisco and publishes a comprehensive archive of digital civil liberties information at one of the most linked-to websites in the world, www.eff.org.

Public Knowledge (PK) is a nonprofit advocacy and education organization dedicated to ensuring that intellectual

property laws and technology policies promote the interests of the public. PK works with a wide spectrum of stakeholders to promote the core conviction that some fundamental democratic principles and cultural values – openness, access, and the capacity to create and compete – must be given new embodiment in the digital age.

NetCoalition serves as the public policy voice for some of the world's most innovative Internet companies on the key legislative and administrative proposals affecting the online world. NetCoalition provides creative and effective solutions to the critical legal and technological issues facing the Internet. By enabling industry leaders, policymakers, and the public engage directly, NetCoalition has helped ensure the integrity, usefulness, and continued expansion of this dynamic new medium.

The Computer & Communications Industry Association (CCIA) is an association of computer, communications, Internet and technology companies that range from small entrepreneurial firms to some of the largest members of the industry. CCIA's members include equipment manufacturers, software developers, providers of electronic commerce, networking, telecommunications and online services, resellers, systems integrators, and third-party vendors. Its member companies employ nearly one million people and generate annual revenues exceeding $300 billion. CCIA's mission is to further the interests of its members, their customers, and the industry at large by serving as the leading industry advocate in promoting open, barrier-free competition in the offering of computer and communications products and services worldwide.

Bloomberg L.P., founded in 1981, is an information services, news, and media company serving customers in 126 countries around the world. The company employs more

than 7,600 people in 108 offices worldwide. Clients include the world's central banks, investment institutions, commercial banks, government offices, and agencies, corporations, and news organizations.

Amici do not have a direct financial interest in the outcome of the case. However, *amici* are deeply concerned about the impact the resolution of this case may have on the information policy articulated by a unanimous Court in *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). In that case, the Court interpreted the Constitution as prohibiting copyright protection for the facts contained in a database. The Court concluded that the Constitution's objective of promoting "the Progress of Science and useful arts" was accomplished by "encourag[ing] others to build freely upon the ideas and information conveyed by a work." *Id.* at 349. The Court has recognized that this fundamental policy of leaving facts in the public domain where they could be incorporated in new works has a First Amendment dimension as well: "Our profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open leaves no room for a statutory monopoly over information and ideas." *Harper & Row, Publishers, Inc., v. Nation Enters.*, 471 U.S. 539, 582 (1985). Affirmance of the decision below could undermine this information policy.

SUMMARY OF ARGUMENT

In *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991), the Court held that the Constitution's Intellectual Property Clause precluded copyright protection for facts. A publisher may copy raw facts at will and include them in a new database. The lower courts' interpretations of Section 43(a) of the Lanham Act could sharply limit the practical effect of *Feist* by requiring a publisher to provide

detailed attribution of the source of each fact that it included in its new database. This could have a negative impact on scientific research and commercial activity.

The threat posed by the lower courts' interpretations of Section 43(a) must be viewed in the context of the broader attacks against *Feist*. Publishers and website operators have employed theories such as breach of contract, trespass to chattels, and the Computer Fraud and Abuse Act to prevent the extraction and transformative use of data. Some publishers have also pursued *sui generis* database legislation in Congress and on the state level.

Any application of the "reverse passing off" doctrine to facts will undermine *Feist*, a landmark decision already under attack. Moreover, application of the Ninth Circuit's interpretation of the Lanham Act to facts would be unconstitutional. It would enable Congress to rely on its power under the Commerce Clause to circumvent a restriction on its power under the Intellectual Property Clause, in violation of this Court's holding in *Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457 (1982).

ARGUMENT

I. LOWER COURT INTERPRETATIONS OF THE LANHAM ACT UNDERMINE THIS COURT'S DECISION IN *FEIST*.

In 1991, this Court in a unanimous opinion in *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991), rejected the "sweat of the brow" doctrine that bestowed copyright protection on the facts contained in databases by virtue of the effort the publisher expended in collecting the facts. Instead, the Court made clear that the Constitution's Intellectual Property Clause permitted copyright to protect only the original expression reflected by

the selection, coordination, and arrangement of the facts. The facts themselves remained in the public domain, free for others to copy and distribute. The lower courts' interpretations of the Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (2000), if allowed to stand, may have the effect of undermining *Feist*.

Respondents in their Opposition to the Petition for a Writ of Certiorari put forth the rather far fetched hypothetical of an aspiring novelist renaming Leo Tolstoy's *War and Peace* as *War in Russia* and selling it under his own name. Opposition at 21. A far more likely scenario appeared in *Feist*. There, Feist "bodily appropriated" listings from Rural Telephone's white pages and incorporated them into its own telephone directory. Under the Ninth Circuit's rule, Feist would have had to attribute those listings to Rural. Moreover, because those listings were interspersed with listings Feist had gathered from other sources, a single attribution at the front of Feist's directory might not have sufficed. Rather, Feist might have had to footnote each listing it obtained from the Rural directory. It similarly might have had to footnote each listing it extracted from a different source.

The Ninth Circuit's ruling, of course, poses problems not only for telephone directory publishers, but also for the authors and publishers of many other types of compilations and fact works. Scientists, economists, and analysts often use large amounts of data from earlier databases in order to construct more comprehensive databases or to compare different data sets. Similarly, historians might extract information from a table and intersperse it throughout a text. The Ninth Circuit's interpretation of Section 43(a) would require each fact to receive its own attribution. To be sure, the ethical rules of some academic disciplines require attribution of the sources of facts, but even they do not require attribution to the degree the Ninth Circuit might require.

Moreover, while an attribution rule might be appropriate in some academic contexts, it could impose significant costs in a business context and could have a chilling effect on the use of information in commerce. For example, a financial newsletter might extract information from a wide variety of sources to compare the performance of various financial instruments. If each individual fact on a comparison table had to have its own footnote, the table might become unreadable. Likewise, the Feist directory would be more difficult for Feist to maintain, and less user friendly, if each listing had to have its own footnote attributing its source.

The Second Circuit's "substantial similarity" rule is only marginally better. *See Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994). Attribution would still be required if the second database incorporated data from the first database as a discrete set rather than integrating the data completely. This is because the discrete set of data in the second database would be "substantially similar" to the data in the first database. For example, a database that listed the batting average of each Major League player by team, rather than alphabetically or by batting average, would have to attribute each team listing to the source of the information for that team, *e.g.*, the team's website.[2] (Under the Ninth Circuit's rule, each player's average would have to be attributed separately if the averages were listed alphabetically or by average.)

The likelihood of confusion test employed by other circuits also is burdensome in the context of facts. In all but the most specialized situations, information users are not likely to care about the source of the information. They do

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[2] Likewise, a database of still images from silent films might require reproduction of the credits for each film adjacent to each image, because each image is "substantially similar" to an image in the film. Even though these images are parts of copyrighted works in the public domain, they are crucial 'facts' about the history of cinema.

not care whether the batting averages were determined by the individual players, the team, the league, the media, or some other entity. All they care about is the accuracy of the information and the ease of its use. To the extent that a given source of information has established a reputation for accuracy, other publishers that extract information from that source will have every incentive to attribute the source of the information, to the extent practicable, to convince consumers of the accuracy of the information in their database. But consumers certainly will not be harmed if the second publisher does not provide attribution, for the extracted information in both databases is the same. Thus, requiring attribution will impose a substantial cost on publishers without any offsetting benefit to consumers.

In sum, the standards for "reverse passing off" under the Lanham Act will erode the effect of this Court's ruling in *Feist*. There, the Court concluded that the Constitution's objective of promoting "the Progress of Science and useful arts" was accomplished by "encourag[ing] others to build freely upon the ideas and information conveyed by a work." *Feist*, 499 U.S. at 349. The Lanham Act, as applied by the lower courts, has the opposite affect: it impedes others from building freely on the information conveyed by a work.

II. *FEIST* IS UNDER ATTACK FROM NUMEROUS QUARTERS.

The threat to *Feist* posed by the Lanham Act must be viewed in the context of a broader attack on *Feist*. Ever since the Court issued *Feist* in 1991, certain database publishers have employed a variety of strategies, with varying degrees of success, to circumvent the effect of the Court's decision.

A. Three Causes of Action Related to Digital Technology Undercut *Feist*.

The most widespread assault comes from shrink-wrap or click-on licenses. In *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996), for example, Zeidenberg copied white page listings from a set of compact discs distributed by ProCD. The CDs contained a "license" which appeared on the computer screen when the user installed the CDs in his computer. The license *inter alia* prohibited the copying of the white page listings. The Seventh Circuit concluded that Zeidenberg was bound by this license, and that Section 301(a) of the Copyright Act did not preempt the license terms prohibiting the copying of information held unprotectable by *Feist*. *ProCD*, 86 F.3d at 1453-1455.

As shrink-wrap and click-on licenses have become more prevalent, so too have the number of cases involving such licenses multiplied. Courts currently are split over whether shrink-wrap or click-on licenses are enforceable;[3] over whether license terms inconsistent with the Copyright Act can be preempted by 17 U.S.C. §301(a) (2000);[4] and over

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[3] *Compare Novell, Inc. v. Network Trade Ctr., Inc.*, 187 F.R.D. 657 (D. Utah 1997); *Morgan Labs., Inc. v. Micro Data Base Sys., Inc.*, 41 U.S.P.Q. 2d 1850 (N.D. Cal.1997); *Step-Saver Data Sys. v. Wyse Tech.*, 939 F.2d 91, 98-100 (3d Cir. 1991); *with Bowers v. Baystate Techs., Inc.*, Case No. 01-1108, 2003 U.S. App. LEXIS 1423 (Fed. Cir. January 29, 2003).

[4] *Compare Selby v. New Line Cinema Corp.*, 96 F. Supp. 2d 1053, 1061 (C.D. Cal. 2000); *Higher Gear Group v. Rockenbach Chevrolet Sales, Inc.*, 2002 U.S. Dist LEXIS 15474, *11 (N.D. Ill. 2002); *Endemol Entertainment, B.V. v. Twentieth Television, Inc.*, 48 U.S.P.Q. 2d 1524, 1525 (C.D. Cal. 1998); *Berkla v. Corel Corp.*, 66 F. Supp. 2d 1129, 1150 (E.D. Cal. 1999); *Arpaia v. Anheuser Busch Cos.*, 55 F. Supp. 2d 151, 162 (W.D.N.Y. 1999); *American Movie Classics Co. v. Turner Entertainment Co.*, 922 F. Supp. 926, 931-32 (S.D.N.Y. 1996); and *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 457 (6th Cir. 2001), *cert. denied*, 534 U.S. 1114 (2002) *with Nat'l Car Rental Sys., Inc. v. Computer Assocs., Int'l, Inc.*, 991 F.2d 426, 433 (8th Cir.), *cert. denied*,

whether such inconsistent terms are constitutionally preempted in accordance with this Court's holdings.[5] Most legal commentators, however, have expressed strong reservations about the enforcement of such terms.[6]

More recently, plaintiffs have alleged that the act of copying information from a website constitutes a trespass to chattels. For example in *eBay, Inc., v. Bidder's Edge, Inc.*,

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510 U.S. 861 (1993) and *Frontline Test Equipment, Inc. v. Greenleaf Software, Inc.*, 10 F. Supp. 2d 583 (W.D. Va. 1998).

[5] Constitutional preemption occurs when the federal and state laws conflict directly, so that compliance with both is a physical impossibility, or when state law "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress." *California Fed. Sav. & Loan Ass'n v. Guerra*, 479 U.S. 272, 281 (1987)(citation omitted). The Court explained that "[t]he offer of federal protection from competitive exploitation of intellectual property would be rendered meaningless in a world where substantially similar state law protections were readily available." *Bonito Boats, Inc., v. Thunder Craft Boats, Inc.*, 489 U.S. 141 151 (1989) (citation omitted). Constitutional preemption precludes the states from "interfer[ing] with the federal policy ... of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." *Id.* at 153. *See also Goldstein v. California*, 412 U.S. 546, 559 (1973); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964); and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964). *Compare Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255 (5th Cir. 1988), *with Bowers v. Baystate Techs., Inc.*, Case No. 01-1108, 2003 U.S. App. LEXIS 1423 (Fed. Cir. January 29, 2003).

[6] *See, e.g.*, 1 Melville B. Nimmer and David Nimmer, Nimmer on Copyright, §1.01[B][1][a] at 1-19 (2002) (suggesting that shrink-wrap licenses may be a "subterfuge"); Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property*, 87 Calif. L. Rev. 111 (1999); Charles R. McManis, *The Privatization (or "Shrinkwrapping") of American Copyright Law*, 87 Calif. L. Rev. 173 (1999); David A. Rice, *Public Goods, Private Contract and Public Policy: Federal Preemption of Software License Prohibitions Against Reverse Engineering*, 53 U. Pitt. L. Rev. 543 (1992); Dennis S. Karjala, *Federal Preemption of Shrinkwrap and On-Line Licenses*, 22 U. Dayton L. Rev. 511 (1997).

100 F. Supp. 2d 1058 (N.D. Ca. 2000), the court granted auction giant eBay a preliminary injunction, concluding that it was likely to prevail on the merits of its state trespass to chattels claim against Bidder's Edge (BE). BE was an "auction aggregator" that combined the auction listings from numerous online auction sites so that a user could go to one site to see what was available on all sites, rather than making separate visits to each auction site. To obtain the auction listings from eBay and the other auction sites, BE used software "web crawlers" that made multiple queries of the eBay auction database.

The court ruled that eBay granted only conditional access to its site, and that BE grossly exceeded those conditions by making repeated queries. *Id.* at 1070. The court also found that BE damaged the eBay website even though it placed a negligible load on eBay's server capacity. *Id.* The court ruled that "[e]ven if, as BE argues, its searches use only a small amount of eBay's computer system capacity, BE has nonetheless deprived eBay of the ability to use that portion of its personal property for its own purposes." *Id.* at 1071. The court held that the mere interference with a possessory interest is sufficient to establish damage.

Two courts have followed *eBay*: *Register.com, Inc. v. Verio, Inc.*, 126 F. Supp. 2d 238 (S.D.N.Y. 2000),[7] and *Oyster Software Inc., v. Forms Processing, Inc.*, No. C-00-0724, 2001 U.S. Dist. LEXIS 22520 (N.D. Cal. December 6, 2001). One court however, refused to find trespass on the basis of mere interference with possessory interest. The court in *Ticketmaster Corp. v. Tickets.com*, Case No. CV99-7654, 2000 U.S. Dist. LEXIS 12987 (C.D. Ca. August 10, 2000), held that "[a] basic element of trespass to chattels

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[7] This case is currently on appeal to the U.S. Court of Appeals for the Second Circuit.

must be physical harm to the chattel ... or some obstruction of its basic function ...."[8]

A third approach to limiting *Feist* is the Computer Fraud and Abuse Act, 18 U.S.C. § 1030 (2000). The CFAA imposes liability on whomever "intentionally accesses a computer without authorization or exceeds authorized access, and thereby obtains ... information from any protected computer if the conduct involved an interstate or foreign communication." § 1030(a)(2)(C).[9] The CFAA permits a private cause of action to be brought by any person who suffers $5,000 of loss by reason of a violation of this section. §§ 1030(a)(5)(B)(i), 1030(g).[10] Because "loss" includes the cost of responding to the offense or conducting a damage assessment, a website operator can obtain injunctive relief and an award of economic damages against a person who extracts without authorization as little as one fact from its website, provided that the operator spends $5,000 on a "damage assessment."

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[8] Most scholars oppose the use of trespass to chattels in online database cases. *See, e.g.*, Edward W. Chang, *Bidding on Trespass: eBay, Inc. v. Bidder's Edge, Inc. and the Abuse of Trespass Theory in Cyberspace Law*, 29 AIPLA Q. J. 445 (2001); Niva Elkin-Koren, *Let the Crawlers Crawl: On Virtual Gatekeepers and the Right to Exclude Indexing*, 26 U. Dayton L. Rev. 179 (2001); Maureen A. O'Rourke, *Shaping Competition on the Internet: Who Owns Product and Pricing Information?*, 53 Vand. L.Rev. 1965 (2000); Dan L. Burk, *The Trouble with Trespass*, 4 J. Small & Emerging Bus. L. 27 (2000).

[9] A "protected computer" is defined as a computer "which is used in interstate or foreign commerce or communication...." § 1030(e)(2)(B). Thus, any computer that is connected to the Internet is a "protected computer."

[10] The term "loss" is defined as "any reasonable cost to any victim, including the cost of responding to an offense, conducting a damage assessment, and restoring the data, program, system, or information to its condition prior to the offense, and any revenue lost, cost incurred, or other consequential damages incurred because of interruption of service."

So far, two courts have found liability under the CFAA for the extraction of information from a publicly accessible website. In *EF Cultural Travel BV v. Explorica, Inc.*, 274 F.3d 577 (1st Cir. 2001), several former employees of EF organized Explorica to compete with EF in the student travel market. In order to determine the prices EF was charging for its tours so that it could underprice them, Explorica used an Internet "scraper" program designed specifically to mine all the necessary price information from the EF website.[11] Similarly, in *Register.com, Inc. v. Verio, Inc.*, 126 F. Supp. 2d 238 (S.D.N.Y. 2000), Register.com, a registrar of Internet domain names, operated a publicly accessible WHOIS database that contained the names and contact information for domain name registrants. Verio, a provider of webhosting and other Internet services, accessed Register.com's WHOIS database by an automated search robot that gleaned specific facts from Register.com's database. Verio used this information to telemarket Internet services to businesses that had recently registered domain names. As noted above, both EF and Verio were found liable for violating the CFAA.

Indeed, the *Verio* court also found Verio liable for breach of contract and trespass to chattels. *Verio*, 126 F. Supp. 2d at 245-251. The contract at issue was a "browse-wrap" license on the Register.com website which stated that if a user issued a query, he agreed not to use the results of the query for

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[11] The court found that Explorica exceeded authorized access because in developing the scraper program, Explorica used proprietary EF travel codes that Explorica employees had obtained under a confidentiality agreement when they worked for EF. *Explorica*, 274 F.3d at 582-583. In a related decision, however, the First Circuit stated that "[a] lack of authorization could be established by an explicit statement on the website restricting access." *EF Cultural Travel BV v. Zefer Corp.*, No. 01-2001, 2003 U.S. App. LEXIS 1336, at *9 (1st Cir. January 28, 2003).

marketing purposes. *Id.* at 245. The court predicated CFAA liability on the breach of this browse-wrap license as well. *Id.* at 253. *Verio* thus demonstrates how these three overlapping theories prevent use of information left in the public domain by *Feist*.

These three theories, if left unchecked, will confer on publishers far more control over facts than did the "sweat of the brow" doctrine found unconstitutional by the Court in *Feist*. Under "sweat of the brow," the defendant had to engage in wholesale copying of the compilation on which the publisher expended great resources. In contrast, under these theories, retrieving even one piece of information from a trivial database on a website can trigger liability.

B. Database Legislation Has Been Introduced To Overturn *Feist*

In addition to developing new causes of action, database publishers have actively pursued *sui generis* database legislation in Congress since 1996. In 1998, in the 105th Congress, database legislation passed the House of Representatives twice – once as a stand-alone bill and once as a title of the Digital Millennium Copyright Act. Fortunately, the database title was dropped by the Conference Committee.[12] In the 106th Congress, the House Judiciary Committee and the House Commerce Committee passed competing database bills. During the recently concluded 107th Congress, the staffs of the House Energy and Commerce and Judiciary Committee engaged in lengthy negotiations in an effort to reach a consensus bill. These negotiations are expected to continue in the 108th Congress.

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[12] *See* Jonathan Band and Makoto Kono, *The Database Protection Debate in the 106th Congress*, 62 Ohio St. L. J. 869, 871 (2001).

Most of the bills introduced closely follow the EU Database Directive, which establishes *sui generis* protection for databases.[13] The stated goal of the database legislation is to restore the "sweat of the brow" protection rejected by this Court in *Feist*. *See* H.R. Rep. No. 106-349, at 10 (1999). The Justice Department, the Federal Trade Commission, and the Department of Commerce observed that such legislation might violate both the Intellectual Property Clause and the First Amendment.[14] Additionally, scholars have challenged these bills on both constitutional and policy grounds.[15]

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[13] Under the Database Directive, EU member states must adopt legislation that "prevent[s] the extraction and/or reutilization of the whole or a substantial part, evaluated qualitatively and/or quantitatively, of the contents of [a] database." Council Directive 96/9/EC of 11 March 1996 on the Legal Protection of Databases 1996 O.J. (L77) 20, at art. 7. H.R. 354 in the 106th Congress provided that "[a]ny person who makes available to others, or extracts to make available to others, all or a substantial part of a collection of information ... so as to cause material harm to the primary market or a related market ... shall be liable ...." For a discussion of the relationship between *Feist* and the Database Directive, *see* Jonathan Band and Laura F.H. McDonald, *The Proposed EC Database Directive: The "Reversal" of Feist v. Rural Telephone*, 9 The Computer Lawyer 19 (June 1992).

[14] *See* Band and Kono at 872; Letter from Robert Pitofsky, Chairman, Federal Trade Commission, to the Hon. Tom Blilely, Chairman, Committee on Commerce, United States House of Representatives (September 28, 1998), *available at* www.ftc.gov/os/1998/9809/antipirabli.htm; Memorandum from William Michael Treanor, Deputy Assistant Attorney, United States Department of Justice, for William P. Marshall, Associate White House Counsel (July 28, 1998), *available at* www.acm.org/usacm/copyright/doj-hr2652-memo.html.

[15] *See, e.g.*, Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 Berkeley Tech. L.J. 535 (2000); Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47 (1999); William

III. CONGRESS CANNOT USE THE COMMERCE CLAUSE TO END-RUN THE INTELLECTUAL PROPERTY CLAUSE.

Any application of the "reverse passing off" doctrine to facts will undermine *Feist*, a landmark decision already under attack. Moreover, application of the Ninth Circuit's interpretation of the Lanham Act to facts would be unconstitutional. It would enable Congress to rely on its power under the Commerce Clause to circumvent a restriction on its power under the Intellectual Property Clause.

In *Feist*, the unanimous Court held that "no one may copyright facts or ideas." *Feist*, 449 U.S. at 353. The Court rejected the "sweat of the brow" doctrine, under which the copyright in a database extended to the facts it contained. The Court stated that the sweat of the brow doctrine "flouted basic copyright principles," *Id.* at 354, and concluded that "only the compiler's selection and arrangement may be protected; the raw facts may be copied at will." *Id.* at 350.

Significantly, the *Feist* Court based its ruling not on the Copyright Act, but on the Intellectual Property Clause of the U.S. Constitution. Article I, Section 8, cl. 8 authorizes Congress "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors ... the exclusive Right to their Respective Writings..." From this clause, the Court inferred that "[o]riginality is a constitutional requirement" for copyright protection, *Feist*, 499 U.S. at 346, and held that facts by definition are not original. They are discovered rather than created. *Id.* at 347.

Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 Geo. Wash. L. Rev. 359 (1999). *See also* H.R. Rep. No. 105-525, at 28-31 (1998) (statement of dissenting views of Rep. Zoe Lofgren, Member, House Comm. on the Judiciary).

The Lanham Act, as interpreted by the lower courts, is in potential conflict with *Feist*'s injunction that "raw facts may be copied at will." *Id.* at 350. The Court in *Railway Labor Executives' Ass'n. v. Gibbons*, 455 U.S. 457 (1982), considered a similar conflict -- a statute enacted by Congress pursuant to the Commerce Clause which provided protection to employees of a railroad in bankruptcy. The Court held that the statute was inconsistent with the uniformity requirement of the Bankruptcy Clause. *Id.* at 471. The Court further held that Congress cannot avoid the particular requirements of one enumerated power by relying on another power; Congress cannot avoid the uniformity requirement of the Bankruptcy Clause by relying on the generality of the Commerce Clause. *Id.* at 468-469.

Congress enacted the Lanham Act pursuant to its power under the Commerce Clause. But under *Railway Labor*, Congress may not invoke the commerce power to do what the Intellectual Property Clause bars it from doing: granting "exclusive Right[s]" in uncopyrightable subject matter. Congress cannot avoid the originality requirement of the Intellectual Property Clause by relying on the general powers of the Commerce Clause.[16]

Stated differently, the Intellectual Property Clause constitutes not only a grant of power to Congress but also a limitation on Congress. *See Bonito Boats*, 489 U.S. at 146 ("[a]s we have noted in the past, the [Intellectual Property] Clause contains both a grant of power and certain limitations upon the exercise of that power"); *Graham v. John Deere Co.*, 383 U.S. 1, 5-6 (1966) ("[t]he clause is both a grant of power and a limitation. . . . Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access

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[16] *See* Julie E. Cohen, *Copyright and The Jurisprudence of Self-Help*, 13 Berkeley Tech. L.J. 1089, 1131-32 (1998).

to materials already available."). The Intellectual Property Clause precludes Congress from providing protection against the copying of facts, and Congress cannot use the Commerce Clause to avoid the implicit strictures of the Intellectual Property Clause, as interpreted by the Court in *Feist.* Congress's reliance on the commerce power does not obviate any of the constitutional limits on the exercise of congressional power under the Intellectual Property Clause.[17]

As a general matter, "reverse passing off" lacks a clear statutory basis.[18] Nevertheless, the reasoning of *Railway Labor* does not invalidate Section 43(a) *per se*; it just precludes an interpretation that requires the attribution of the source of facts.

In addition to conflicting with the Intellectual Property Clause, the Lanham Act as applied to facts also raises serious First Amendment concerns. It is well settled that copyright's abhorrence of protection for facts has a clear First Amendment dimension. As the Court stated in *Harper & Row, Publishers, Inc. v. Nation Enters.* 471 U.S. 539, 582 (1985):

> Our profound national commitment to the principle that debate on public issues should

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[17] *See* William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 Geo. Wash. L. Rev. 359 (1999).

[18] Courts steer Section 43(a) into dangerous waters when they remove it from its consumer protection function. As this Court stated with respect to the trademark laws, "its general concern is with protecting consumers from confusion as to source. While that may result in the creation of quasi property rights in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation." *Bonito Boats*, 489 U.S. at 157. The potential application of "reverse passing off" to facts illustrates these dangers: Consumers cannot be harmed by the "bodily appropriation" of data without attribution, since the information loses nothing in genuineness or reliability from its transposition.

> be uninhibited, robust, and wide-open leaves no room for a statutory monopoly over information and ideas. The arena of public debate would be quiet, indeed, if a politician could copyright his speeches or a philosopher his treatises and thus obtain a monopoly on the ideas they contained. A broad dissemination of principles, ideas, and factual information is crucial to the robust public debate and informed citizenry that are the essence of self-government. And every citizen must be permitted freely to marshal ideas and facts in the advocacy of particular political choices.

(Citations and quotation omitted.)

Earlier this term, the Court enlarged on this theme when it observed that the "copyright law contains built-in First Amendment accommodations" such as the idea/expression dichotomy. *Eldred v. Ashcroft*, 123 S. Ct. 769, 71 U.S.L.W. 4052 (2003). Quoting *Harper & Row*, the Court stated that the "idea/expression dichotomy strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting the free communication of facts while still protecting an author's expression." *Id.* at 789, *quoting* 471 U.S. at 556. The Court concluded that "[d]ue to this distinction, every ... fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication." A Lanham Act impediment to the use of facts frustrates this critical First Amendment accommodation.

CONCLUSION

Feist already is in danger of death from a thousand cuts: shrink-wrap licenses, trespass to chattels, the Computer Fraud and Abuse Act, and *sui generis* database legislation. The Court should not compound this danger by allowing

Section 43(a) to impose an attribution requirement on facts copied from another source. Such a requirement would undermine the United States' fundamental information policy articulated in *Feist*: "all facts -- scientific, historical, biographical, and news of the day .... are part of the public domain available to every person." *Feist*, 499 U.S. at 348 (citations and quotations omitted).

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